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Application Number

09/912.779

Filing Date

07/25/2001

First Named Inventor

John P. Kandla

Art Unit

2684

Examiner Name

Shaima Q. Aminzey

Attorney Docket Number

RPS920000402US2

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/
Incomplete ApplicationReply to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



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Petition to Convert to a
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Winstead Sechrest & Minick P.C.

Signature

Printed name

Robert A. Voigt, Jr.

Date

10/24/2005

Reg. No.

47,159

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- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Karidis et al.	:	Aminzay, Shaima Q.
	:	
Serial No.: 09/912,779	:	Group Art Unit: 2684
	:	
Filing Date: July 25, 2001	:	
	:	
Title: PERSONAL	:	IBM Corporation
COMMUNICATION DEVICE	:	P.O. Box 12195
HAVING A BUILT-IN	:	Dept. 9CCA, Bldg. 002-2
PROJECTION DISPLAY	:	Research Triangle Park, NC 27709

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated August 26, 2005, with a two-month statutory period for response set to expire on October 26, 2005.

CERTIFICATION OF MAILING

I hereby certify that this correspondence is being mailed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October __, 2005.

Signature

Toni Stanley*(Printed name of person certifying)*

I. RESPONSE TO EXAMINER'S ARGUMENTSA. Response to Examiner's assertion that Appellants are missing statements in Appellants' Appeal Brief, as discussed on pages 3-4 of Examiner's Answer.

The Examiner has asserted that certain statements, e.g., status of amendments filed after final rejection, issues section, grouping of claims section, do not appear in Appellants' Appeal Brief. Examiner's Answer, pages 3-4. Appellants note that the format of an Appeal Brief has changed as of September 13, 2004. Appellants' Appeal Brief was filed on July 19, 2005 and hence the new rules (37 C.F.R. §41.37) govern what items are to be included in the Appeal Brief. The Examiner appears to be following the old rules and not the new rules as far as determining whether Appellants have included the appropriate statements. Appellants believe they have followed the new rules and have included the appropriate items. Appellants do acknowledge, however, not addressing the status of claim 1 under the section entitled "Status of Claims." Claim 1 has been allowed by the Examiner.

B. Response to Examiner's argument, as discussed on pages 7-12 of Examiner's Answer, that the Examiner presented objective evidence and sufficient motivation for modifying Takahashi with Novis.

The Examiner contests Appellants assertion that the Examiner admitted that Takahashi does not teach "wherein sufficiently-sized characters are displayed in a manner visible to the user without further magnification" as recited in claim 13. Examiner's Answer, page 9. Appellants are confused as to what portion of the above-cited limitation that the Examiner is admitting that Takahashi does not teach. Is it simply the clause "without further magnification"? If so, then it appears to Appellants that it is appropriate to say that Takahashi does not teach displaying sufficiently-sized characters in a manner visible to the user without further magnification. The "without further magnification" is connected to the other words in the claim limitation and it does not seem to make sense to discuss "without further magnification" without connecting the clause to the other words in the claim limitation.

Further, the Examiner asserts that the Examiner's motivation is proper since Novis suggests in the Background and Summary that magnification is necessary. Examiner's Answer, page 10. Appellants respectfully traverse. The Examiner has not specifically cited to any passage in the Background or Summary of Novis as evidence that Novis suggests that magnification is necessary. Instead, Novis teaches the need to integrate a smart card interface, as well as a cellular transceiver, and a visual display into a portable electronic device, while maintaining portability and ease in carrying the device. Column 1, lines 60-63. Novis further teaches that it is the purpose of the present invention to provide new and improved apparatus including a two-way voice communications transceiver, a smart card interface and a visual image display. Column 2, lines 1-4. Novis further teaches that to provide for new and improved apparatus for viewing, editing and performing various types of wireless commercial, financial and service related transactions, utilizing smart card technology and wireless two-way voice transmissions and so on. Column 2, lines 5-9. There is no language in either the Background or Summary of Novis that suggests that magnification is necessary. The Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness in rejecting claim 13. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

The Examiner appears to be asserting that it is sufficient evidence to show motivation to combine references by pointing out that the references are from the same class. Examiner's Answer, page 11. The mere fact that references can be combined or modified does not render the resultant combination obviousness unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990). This is the reason why simply having references from the same class is not sufficient evidence for establishing a *prima facie* case of obviousness. The Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness in rejecting claim 13. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner asserts that Appellants are only focusing on Novis in their argument that the Examiner has not provided objective motivation for modifying Takahashi with Novis. Examiner's Answer, page 11. Appellants will attempt to clarify any misunderstanding. The Examiner's motivation does not address as to why one of ordinary skill in the art would modify Takahashi to display sufficiently-sized characters in a manner visible to the user without further magnification. Takahashi addresses the problem of having a display section of conventional portable telephone sets not being large enough for dealing with the amount of character data normally processed at a time in the portable telephone set. Column 2, lines 10-15. The Examiner cites column 2, lines 14-15, 30-38; column 8, lines 31-39 of Novis as the source of motivation for modifying Takahashi to display sufficiently-sized characters in a manner visible to the user without further magnification. Examiner's Answer, pages 10-11. The passages cited in Novis as support for the Examiner's motivation teach that the purpose of the present invention of Novis is to perform transactions utilizing a smart card, which contains safe features to prevent unwarranted viewing and use of the information and the smart card. The Examiner's motivation (to perform transactions utilizing a smart card, which contains safe features to prevent unwarranted viewing and use of the information and the smart card) does not address as to why one of ordinary skill in the art would modify Takahashi to display sufficiently-sized characters in a manner visible to the user without further magnification. Performing transactions utilizing a smart card, which contains safe features to prevent unwarranted viewing and use of the information, is immaterial to overcoming the problems of Takahashi (having a display section of conventional portable telephone sets not being large enough for dealing with the amount of character data normally processed at a time in the portable telephone set). The Examiner must provide objective evidence as to why one of ordinary skill in the art would modify Takahashi to display sufficiently-sized characters in a manner visible to the user without further magnification. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner has not provided such evidence. Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claim 13. *Id.*

- C. Response to Examiner's argument, as discussed on pages 12-14 of Examiner's Answer, that Takahashi and Novis, taken singly or in combination, teach the limitations of claim 13.

The Examiner asserts that more content can be displayed in the open state (Examiner asserts that the open state, as taught in Takahashi, corresponds to the projection-view mode) than in the closed state (Examiner asserts that the closed state, as taught in Takahashi, corresponds to the direct-view mode). Examiner's Answer, page 13. Appellants respectfully traverse for the reasons stated in Appellants' Appeal Brief. The Examiner has not provided any evidence supporting such a conclusion.

Further, the Examiner asserts that Appellants argue the need for using Novis as a second reference. Examiner's Answer, page 13. Appellants, on pages 6-9 of Appellants' Appeal Brief, are simply addressing the Examiner's rejections and are not asserting that the Examiner does or does not need to use Novis as a second reference in his rejection of "a personal communication device comprising a dual mode display for a user's viewing in both a direct-view mode, wherein sufficiently-sized characters are displayed in a manner visible to the user without further magnification, and in 'projection-view' mode, wherein more content can be displayed over that of the direct-view mode" as recited in claim 13. Appellants are confused as to why the Examiner is asserting that Appellants are arguing the need for using Novis as a second reference.

- D. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellants' Appeal Brief and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION

For the reasons stated in Appellants' Appeal Brief and noted above, Appellants respectfully assert that the rejection of claim 13 is in error. Appellants respectfully request reversal of the rejection and allowance of claims 1, 3-8 and 10-14.

Respectfully submitted,

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